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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/930,235	02/23/1998	ANJA EITRICH	BEIERSDORF45	2748

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 4, 2003 & Sept 24, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 4-8 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allard et al. 5,616,331 of record. Allard et al. (Example 1; paragraph bridging columns 2 and 3; column 5, lines 47-65; column 6, lines 39-49) discloses transparent or translucent microemulsions of the oil-in-water type containing an oil phase, e.g., liquid petroleum, cetyl-stearyl alcohol containing 15 EO 6.6% and glyceryl stearate 3.4%, nano-pigmentary TiO₂ and an aqueous phase. The microemulsions having been obtained by the phase inversion technique. While the microemulsion of example 1 of Allard et al

contains more than 11.8% oil phase, it is evident from Allard et al (column 5, lines 28-43, esp. lines 34-36) that patentees contemplate the use of as little as 5% oily phase and that 10% oily phase is preferred to them. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ such low oily phase concentrations in the microemulsions of Allard et al to render them less expensive by reducing the amount of the oily phase relative to the aqueous phase. Moreover, it is well settled that choice of suitable or optimum concentrations of ingredients is well within the expected skill of a worker in the art. See *Aller et al.*, 105 USPQ 223, 220 F.2d 454.

Response to Arguments

4. Applicant's arguments filed August 4, 2003 have been fully considered but they are not persuasive.
5. Applicants (page 4, 8/4/2003 response) assert the conclusion that Allard et al contemplates microemulsions is erroneous because the particle size is but one property of microemulsions and there is no evidence of record that the Allard et al emulsions possess any other microemulsion properties. This has not been deemed persuasive. A key property of microemulsions is thermodynamic stability. Allard et al discloses the compositions as (column 6, line 17 and 43-47; Table 1; and claims) perfectly homogeneous and stable over time. Macroemulsions on the other hand are not thermodynamically stable and not perfectly homogeneous.
6. Applicants' (page 4) assertions regarding Allard et al teaches compositions translucent to the skin have not been deemed persuasive. Table 1 of Allard et al

explicitly sets forth the emulsions (F1) are not visible with an optical microscope and therefore would be expected to be at a minimum, translucent.

7. Applicants' (pages 4 and 5) arguments regarding Allard et al use of the term emulsion and ultrafine emulsion and a distinction based on the use of said terms rather than microemulsion has not been deemed persuasive. The evidence showing at least translucent, perfectly homogeneous and stable over time emulsions taught in the Allard et al reference outweighs any evidence of record to the contrary.

Clearly emulsions defined by particle size and appearance may take various forms and said forms are made up of various average particle size and various particle size distributions. Allard et al teaches an average particle size of within the range of 10 nm. See claim 2. This clearly includes particles of less than 100 nm and possibly greater than 100 nm. Allard et al clearly teaches translucent compositions in Table 1, which applicants claims set forth. Furthermore, the skilled artisan employing less oily phase as clearly contemplated in the Allard et al reference would have generally expected increased stability based on the increased emulsifier to oily phase ratio.

8. Lastly, applicants assertion that even though the Allard et al reference may show compositions having characteristic that are close to the claimed invention, the modification would change the Allard et al compositions to an wholly different composition. This is not deemed persuasive. Allard et al clearly teaches the failings of the prior art (column 3, lines 2-7) regarding the transparency, homogeneity and stability because of oil globular size, i.e., because the oil globules are greater than those produced by phase inversion set forth in column 6, line 15. Smaller particle size

emulsions, eg, ultrafine or microemulsions, would be expected to those of ordinary skill in the art to be more stable, homogeneous and desirous based on said stability and homogeneity. Said fact is clearly recognized in the Allard et al reference.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1089.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM